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8/29/03
Paper No. 31
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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Woodflame Inc.

Serial No. 75/344,125

Jess M. Collen of Collen Intellectual Property Law, P.C.
for Woodflame Inc.

Tricia L. Sonneborn, Trademark Examining Attorney, Law
Office 110 (Chris A. F. Pedersen, Managing Attorney).

Before Cissel, Hohein and Bottorff, Administrative
Trademark Judges.

Opinion by Cissel, Administrative Trademark Judge:

On August 20, 1997, the predecessor of applicant, a
Canadian corporation doing business in Quebec, filed the
above-referenced application to register the mark shown
below



on the Principal Register for cooking, grilling, and barbecuing¹ apparatus using generally wood fuel: namely, barbecue grill, smoker, camp stove, outdoor heater, stove, water-heater and related accessories, namely barbecue carrying bags, slicing boards, spray bottles, grill cleaning powder, cookbooks and recipes on video cassettes, cooking and eating utensils, namely; knives, forks, spoons, spatulas, tongs, metal brushes, meat skewers, sauce brushes, metal grills, scrapers, sauce whisks, thermometers, fish grills, bread grills, salt and pepper sets, spice boxes, aluminum pans, marinade pans, drip pans, pie plates, [w]oks, pancake hot plates, fuels, aprons, mittens, caps, hats, t-shirts." The application was filed based on applicant's assertion that it possessed a bona fide intention to use the mark in commerce in connection with these products. Applicant also based the application on its application to register the mark in Canada. That application was filed on June 18, 1997. Applicant claimed a right of priority under Section 44 of the Lanham Act

¹ Throughout the prosecution of this application, applicant has alternated the spelling of the term with the letter "c" or the letter "q." As the various amendments to the application are recounted in this opinion, we will show the spelling used in the particular amendment being discussed.

based on its Canadian application.

The Examining Attorney found the identification-of-goods clause in the application to be unacceptable because it was too broad and contained items classified in more than one class. She suggested acceptable language for goods in Classes 3, 4, 8, 9, 11, 16, 21, 25 and 28, and advised applicant of the procedure for converting the application into a combined application for all such products. Additionally, with regard to the goods in Classes 3, 4 and 11, she required applicant to disclaim the descriptive terminology "WOODFLAME GRILL" apart from the mark as shown. Applicant was also advised that it had to submit the foreign application serial number and a certification or certified copy of the Canadian registration resulting from it.

Responsive to the first Office Action, applicant amended the identification-of-goods clause to read as follows: "fuel oil, wood chips for use as fuel in international class 4; cooking, grilling and barbequing apparatus using generally wood fuel, namely, barbecue grill, smoker, camp wood burning stove, wood burning stove, outdoor wood burning heater, hot water heater, fish grill, bread grill and electric hot plates in international class 11." Applicant requested that the application be amended

to disclaim the exclusive right to use the word "grill" apart from a mark as shown. Applicant advised that as soon as it became available, a certified copy of the Canadian registration would be submitted.

The Examining Attorney maintained and made final the requirement for applicant to disclaim the term "WOODFLAME GRILL" apart from the mark as shown on the ground that the entire term, not just the word "GRILL," is merely descriptive of applicant's goods within the meaning of Section 2(e)(1) of the Lanham Act. The Examining Attorney concluded that the goods are fuel for or devices used for cooking with a wood flame, and that this is a significant characteristic of applicant's products. Dictionary definitions were submitted for the words "wood" as "the secondary xylem of trees and shrubs... often cut and dried especially for use as building material and fuel," and for "flame" as "the zone of burning gases and fine suspended matter associated with rapid combustion; a hot, glowing mass of burning gas or vapor."

Also submitted with the final refusal to register were excerpts of articles retrieved from a database of publications. Each such article uses the term "wood flame" or its plural in reference to a fire with wood as its fuel. Examples include the following:

... focal point is the big open kitchen and its mammoth rotisserie where whole fish, lobsters, ducks and sundry roasts revolve over wood flames that warm the whole room. The New York Times, Feb. 22, 1998.

The wood-flame flavor of my sirloin (\$12.95) was excellent, but the slice was just too thin to come out rare, as I requested. The Boston Globe, Oct. 12, 1997.

Part of the explanation for their popularity lies with the pottery itself. Licked and scorched by wood flame, glazed and encrusted with wood ash, anagama ware contrasts sharply with ware produced in tamer environments... Harper's Magazine, January, 1998.

Two other examples were also provided, but because of the titles of these publications, it is not at all clear whether they constitute evidence of the perceived meaning of the term "wood flame" in the United States.

Applicant timely filed a Notice of Appeal, followed by a timely-filed appeal brief. The Examining Attorney requested that the appeal proceeding be suspended and that the application be remanded to the Examining Attorney pending receipt and examination of applicant's certified Canadian registration. The Board granted the request.

Applicant did submit a certified copy of the Canadian registration, thus satisfying the requirements for filing the application under Section 44(d) of the Act. In addition to noting informalities that needed to be corrected, the Examining Attorney continued what she

characterized as the requirement for applicant to disclaim the term "WOODFLAME."

Additionally, she found that the identification of goods in International Class 4 exceeded the scope of the Canadian registration. Applicant was directed either to limit the identification by deleting reference to fuel oil and wood chips for use as fuel or to claim the goods in Class 4 under Section 1(b) only, as opposed to claiming both Section 1(b) and Section 44(e) as the bases for filing the application with regard to these goods.

Applicant responded by amending the application to state the goods and the filing bases as follows:
"fuel oil, wood chips for use as fuel, in International Class 4," with a filing basis of Section 1(b); and
"cooking, grilling, and barbecuing apparatus using generally wood fuel, namely, barbecue grill, smoker, camp wood burning stove, wood burning stove, outdoor wood burning heater, hot water heater, fish grill, bread grill and electric hot plates, and International Class 11," with Sections 1(b) and 44(e) as the bases for filing as to the goods in that class.

Following approval of the amendment by the Examining Attorney, the application was returned to the Board for resumption of action on the appeal. Applicant filed its

appeal brief and the Examining Attorney filed hers. Applicant filed a reply brief, but canceled the oral hearing which had been scheduled. Accordingly, we have resolved this appeal based on the written record and the arguments presented in the briefs.

The issue presented by this appeal is whether the term "WOODFLAME GRILL" is merely descriptive of the goods identified in the application within the meaning of Section 2(e)(1) of the Lanham Act.² If it is, it must be disclaimed under Section 6(a) of the Act.

The guidelines for determining whether a mark is merely descriptive of the goods with which it is, or will be, used are well settled. A mark is merely descriptive under this section of the Act if it immediately and forthwith conveys information concerning a significant quality, characteristic, feature, function, purpose or use of the goods. In re Gyulay, 820 F.2d 1216, 3 USPQ 2d 1009

² The requirement for a disclaimer of the combination of these two words was made in the first Office Action and maintained and made final in the second, notwithstanding that applicant had disclaimed "GRILL" by that time. Although the discussion and argument between the Examining Attorney and applicant from that point on focused on the descriptiveness of "WOODFLAME," the final requirement was for the combination term to be disclaimed, so we have considered this to be the issue on appeal. Moreover, applicant has never contended that although both words are merely descriptive in connection with the goods, the combination of them is not. Applicant's argument is that "WOODFLAME" is not merely descriptive of its goods within the meaning of the statute.

(Fed. Cir. 1987); *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978). It is not necessary that a term describe all of the properties or functions of the goods in order for it to be considered to be merely descriptive of them; rather, it is sufficient if the term describes any significant attribute or idea about them. Moreover, whether a term is merely descriptive is determined not in the abstract, but rather in relation to the goods or services for which registration is sought, the context in which the mark is being used (or is intended to be used) in connection with those goods and the possible significance that the term would have to the average purchaser of the goods because of the manner of its use. See: *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979). A mark is suggestive, rather than merely descriptive, if, when the goods are encountered under the mark, a multi-stage reasoning process, or the use of imagination, thought or perception is required in order to determine what attributes of the goods the mark indicates. *In re Mayer-Beaton Corp.*, 223 USPQ 1347 (TTAB 1984).

As we have noted repeatedly, there is a thin line of demarcation between a suggestive mark and one that is merely descriptive, with the determination of which category a mark falls into frequently being a difficult

matter involving a good measure of subjective judgment. See, e.g., *In re Atavio*, 25 USPQ2d 1361 (TTAB 1992), and *In re TMS Corp. of the Americas*, 200 USPQ 57 (TTAB 1978). A word which combines descriptive terms may be registrable only if the composite creates a unitary mark with a separate, nondescriptive meaning. *In re Ampco Foods, Inc.*, 227 USPQ 331 (TTAB 1985). The fact that an applicant may be the first and only user of a merely descriptive mark does not justify registration of it. *In re National Shooting Sports Foundation, Inc.*, 219 USPQ 1018 (TTAB 1983).

In the instant case, applicant has conceded the descriptiveness of the disclaimed word "GRILL," and the term "WOODFLAME" is merely descriptive in connection with "wood chips for use as fuel," in Class 4, and for the "cooking, grilling and barbecuing apparatus using generally wood fuel" listed in Class 11 because it identifies a significant characteristic or attribute of these products, namely, that the wood chips and grills utilize a wood flame to provide the heat with which to cook. Prospective purchasers of applicant's cooking equipment and fuel for it would understand from the ordinary meanings of the words "wood," "flame" and "grill" that applicant's products are grills or fuels for grills that utilize a wood flame, as

opposed to a charcoal flame or a gas flame, each of which may have its own culinary advantages and disadvantages. No imagination or multi-step reasoning process is necessary in order to reach this conclusion, and the combination of these descriptive words does not result in any incongruity or in a term that is either meaningless or nondescriptive.

Applicant's arguments to the contrary are not well taken. As noted above, they center around the contention that the word "WOODFLAME" is only suggestive of a possible feature that the goods might have. Applicant repeatedly argues that because applicant coined the term and it has no dictionary definition, it cannot be considered to fall within the proscription of Section 2(e)(1) of the act.

This argument is not well taken, however. As noted above, the likely meaning to be ascribed to the combination of the descriptive terms "wood" and "flame" in connection with the goods listed in the application is the descriptive one. That applicant may be the first or only one to have combined the descriptive words "wood" and "flame" in this manner in connection with these goods does not make the combination any less descriptive.

Applicant nonetheless argues that the term is only suggestive of the goods identified in the application because it suggests that the food items cooked on

applicant's apparatus or with applicant's fuel "are invested with a particular flavor or characteristic." (reply brief, p. 2.) However, the connotation urged by applicant relates not to the products applicant will sell under the mark, which are grills and fuel for use in them, but instead to the food which will be prepared by using these products. The connotation of the term argued by the Examining Attorney (and demonstrated by the evidence) is more apposite, because it relates directly to the goods specified in the application. The obvious meaning of the term in connection with these goods is much more likely to be the one understood by prospective purchasers who are presented with the mark on applicant's grills and wood chip fuel for them.

Applicant contends that the examples of the use of "wood flame" in the excerpted published articles submitted by the Examining Attorney are insufficient evidence upon which to base the requirement for disclaiming the term. While this evidence by itself might not meet the Examining Attorney's burden of proving the descriptiveness of the term, it certainly supports her position. That one of the flames discussed in one article is being used to fire pottery does not reduce the probative value of that excerpt. What it and the other excerpts quoted above show

is that "wood flame" is a term used to describe a fire which is fueled by wood. Along with the dictionary definitions, this evidence makes clear the descriptive significance the term has in connection with cooking apparatus and wood fuel for use in such products. Applicant has not submitted any evidence in support of the argument that the term would not be understood in its descriptive sense in connection with the goods specified in the application.

In summary, "WOODFLAME" is merely descriptive in connection with both wood chips for use as fuel and the cooking apparatus identified in the application because the term identifies a significant characteristic of these products, namely that they use a wood flame to produce the heat used to cook with them. The descriptiveness of the word "GRILL" in connection with applicant's goods is conceded. The combination of the two words has no significance that is not descriptive as well. In that the term "WOODFLAME GRILL" would be unregistrable by itself under Section 2(e)(1) of the Act, it must be disclaimed apart from the mark as a whole in accordance with Section 6(a).

DECISION: The requirement for a disclaimer of "WOODFLAME GILL" is affirmed. If applicant submits a

Ser No. 75/344,125

disclaimer of this term within thirty days of the mailing date of this decision, the decision will be set aside under Trademark Rule 2.142(g) and the application will proceed to publication.